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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/243,101	02/02/1999	JOSHUA B. SUSSER	08993/007001	2006

7590 11/19/2003  
Thelen Reid & Priest LLP  
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San Jose, CA 95164-0640

EXAMINER

VU, TUAN A

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/243,101

Applicant(s)

SUSSER ET AL.

Examiner

Tuan A Vu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 59-150 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 59-150 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 18.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to the Applicant's response filed 09/16/2003.

As indicated in Applicant's response, claims 59-150 are pending in the office action.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 59-67, 69-75, 77-84, 86-92, 94-107, 109-121, 123-135, and 137-149 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by document Draft 2a (with no author) "Java Card Virtual Machine Specification", January 1999, Sun Microsystems, Java Card Version 2.1(hereinafter JVcard21).

**As per claims 59, 77, 95, and 123**, see JVcard21 chap. 6.

**As per claims 60-61**, see JVcard21, chap. 6.8-6.10.

**As per claim 62**, see JVcard21, chap. 3.1, 3.10.

**As per claim 63**, see JVcard21, chap. 3.10.

**As per claims 64-65**, see JVcard21 ( *1K RAM*- chap. 2.1)

**As per claim 66**, see JVcard21 ( preface, chap. 1.2).

**As per claim 67**, see JVcard21 ( preface).

**As per claims 69, 87, 109 and 137**, JVcard21 discloses a composite instruction (see chap. 3.10, 6-7)

**As per claims 70-71**, see JVcard21, chap. 3.1, 3.10.

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**As per claims 72-73**, see JVcard21( *IK RAM*- chap. 2.1)

**As per claims 74-75**, refer to claims 66-67 respectively.

**As per claims 78-79**, refer to claims 60-61.

**As per claims 80-81**, refer to claims 62-63.

**As per claims 82-83**, see claims 64-65.

**As per claims 84 and 86**, see JVcard21, preface and chap. 1-2.

**As per claims 88-89**, refer to claims 62-63.

**As per claims 90-91**, see claims 64-65.

**As per claims 92 and 94**, refer to claims 84, 86.

**As per claim 96**, see JVcard21 ( chap. 1, Fig. 1-2).

**As per claim 97**, see JVcard21 ( chap. 1, 7).

**As per claim 98**, refer to claim 96.

**As per claim 99**, see JVcard21, chap. 6.10.

**As per claims 100-101**, refer to claims 60-61.

**As per claims 102-103, 116-117, 130-131 and 144-145**, refer to claims 62-63.

**As per claims 104-105, 118-119, 132-133, and 146-147**, refer to claims 64-65.

**As per claims 106-107, 120-121, 134-135, and 148-149**, refer to claims 66-67.

**As per claims 110-115, 124-129, and 138-143**, refer to claims 96-101 for corresponding rejections.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 68, 76, 85, 93, 108, 122, 136, and 150 are rejected under 35 U.S.C. 103(a) as being unpatentable over JVcard21, "Java Card Virtual Machine Specification", January 1999, Sun Microsystems, Java Card Version 2.1 as applied to claims 59, 69, 77, 87, 95, 109, 123, and 137 above, in view of Wilkinson et al., USPN: 6,308,317 ( hereinafter Wilkinson).

As per claims 68, 76, 85, 108, 122, 136, and 150, JVcard21 discloses a resource-constrained card and motivation to embed multitude of application programs into a smart card that support such applicability while maintaining a limited storage (preface, ch. 2) but does not specify a ASIC. Wilkinson, in a system to configure and execute application program on a resource-constrained card analogous to JVcard21, discloses a integrated circuit ( Fig. 1). It would have been obvious for one of ordinary skill in the art at the time the invention was made to implement the card as taught by JVcard21 so that it is a special application integrated circuit card as taught by Wilkinson because this would further enable actualizing the functionality of the smart card while alleviating redundant expense of resources by providing application-specific hardware embedding specifically purported circuit design for such resources-constrained device to operate in.

### ***Response to Arguments***

6. Applicant's arguments filed 09/16/2003 have been fully considered but they are not persuasive. The following are the reasons therefor.

Applicants remarked that the reference used in the previous action, i.e. Draft 2a, is dated January 29, 1999, but that it is not the date of publication ( Appl. Remarks, pg. 3) because such

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reference was made available only after Feb. 2, 1999, the application filing date, and that the reference was an improper reference. Examiner likes to point out that in order for the rejection to be overcome, the Applicants are required to prove that first, the reference is not published as explicitly printed on the front of the document 'Draft 2a'; and second, it is an internal document proprietary only to the group working with the Applicants, i.e. such document and the application being co-owned by the inventor(s). The provisions as specified in the MPEP state that only an affidavit under 37 CFR 1.131 and/or 37 CFR 1.132 would enable the rejection as applied in the action to be overcome. The statements by Applicant's representative as presented in the response are deemed to be not in the correct format; and until such affidavits are filed appropriately, the rejection as used still applies.

Applicants also stated that the reference has been incorporated by reference in the specifications (Appl. Remarks, pg. 3, bottom, pg. 4, top). The fact that a reference is included in the invention's disclosure as being incorporated by reference does not preclude the fact that such reference is published prior to the invention and owned by a different inventive entity as well, hence does not rule out its being a valid prior art for use in a corresponding type of rejection. The Applicants are required to submit an affidavit according 37 CFR 1.131 and/or 37 CFR 1.132 as indicated above because as presented in the response, the arguments are not deemed to be in proper format for consideration.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A Vu whose telephone number is (703)305-7207. The examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703)305-9662.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9306 ( for formal communications intended for entry)

**or:** (703) 746-8734 ( for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA. , 22202. 4<sup>th</sup> Floor( Receptionist).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

VAT

November 12, 2003

*Kakali Chaki*  
**KAKALI CHAKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100**